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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,027	08/27/2003	Fred H. Burbank	R0367.00302	6463
61808 7590 12/10/2007 EDWARD J. LYNCH, PATENT ATTORNEY ONE EMBARCADERO CENTER SUITE 562 SAN FRANCISCO, CA 94111			EXAMINER SZMAL, BRIAN SCOTT	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 12/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/650,027

Applicant(s)

BURBANK ET AL.

Examiner

Brian Szmal

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-30, 32, 33, 35-38, 40-54 and 56-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 63 and 64 is/are allowed.
- 6) ☒ Claim(s) 28, 32, 33, 42, 45-48, 51-53 and 58-62 is/are rejected.
- 7) ☒ Claim(s) 29, 30, 35-38, 40, 41, 43, 44, 49, 50, 54, 56 and 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 28, 32, 33, 42, 45-48, 51-53, 58 and 62 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8-14, 18, 19, 22 and 23 of U.S. Patent No. 6,758,848 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the issued claims are written in a broader language than the current claims. Even though the current claims of the application and the issued claims are not identical, the issued claims "anticipate" the current claims of the instant application, and therefore are not patentably distinct from one another.

### ***Claim Objections***

3. Claim 28 is objected to because of the following informalities: In line 14, "an inner transverse dimension" appears it should read as "the inner transverse dimension" due to the previous disclosure of "an inner transverse dimension" in line 3 of the claim. Appropriate correction is required.

### ***Specification***

4. The abstract of the disclosure is objected to because the Abstract submitted on September 20, 2007 exceeds 150 words. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 58, 59, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank et al (5,928,164) in view of Tihon et al (5,415,656).

Burbank et al disclose a biopsy device with a piercing distal tip (45) and further disclose an elongated shaft (44) which has a proximal end and a distal end with a transverse dimension and which has an inner lumen extending within at least a part of a proximal shaft portion; an elongated cutting member (68) having a longitudinal axis and a distal cutting surface which lies in a plane traversing the longitudinal axis; and the

elongated cutting member (68) is disposed in part within the elongated shaft (44). See Figure 13A.

Burbank et al however fail to disclose an arcuate cutting electrode which extends over and is secured to the distal end, which is spaced distally from the distal end and which has a chord length greater than the transverse dimension on the distal end; an electrical conductor which has a first end electrically connected to the tissue cutting electrode and which has a second end configured to be connected to a high frequency electrical power source; and a return electrode effective to provide a return electrical path for electrical current from the tissue cutting electrode.

Tihon et al disclose an electrosurgical apparatus and further disclose an arcuate cutting electrode (18) which extends over and is secured to the distal end, which is spaced distally from the distal end and which has a chord length greater than the transverse dimension on the distal end (the length of the electrode when straightened out is greater than the diameter of the distal end); an electrical conductor which has a first end electrically connected to the tissue cutting electrode and which has a second end configured to be connected to a high frequency electrical power source; and a return electrode effective to provide a return electrical path for electrical current from the tissue cutting electrode. See Column 5, lines 58-64; and Figure 6.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the distal tip of Burbank et al to include the use of an electrosurgical cutting electrode for the tip, as per the teachings of Tihon et al, since it is well known in the art to utilize an electrosurgical cutting electrode on a distal tip of a

device since it provides a device that causes less trauma while entering the tissue as well as providing a means of hemostasis by cauterizing severed blood vessels.

7. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank et al (5,928,164) and Tihon et al (5,415,656) as applied to claim 58 above, and further in view of Klicek (5,221,281).

The combination of Burbank et al and Tihon et al, as discussed above, disclose a biopsy device with an electrosurgical cutting electrode at the distal tip, but fail to disclose the return electrode is contained on the elongated shaft.

Klicek discloses an electrosurgical control for a trocar and further disclose return electrode is contained on the elongated shaft. See Column 7, lines 15-20.

It would have been obvious to one of ordinary skill in the art at the invention was made to modify the combination of Burbank et al and Tihon et al to include the use of a return electrode on the elongated shaft, as per the teachings of Klicek, since it is well known in the art to utilize a bipolar electrode setup in electrosurgical devices since it prevents the use of a large return electrode placed on the patient's back.

#### ***Allowable Subject Matter***

8. Claims 29, 30, 35-38, 40, 41, 43, 44, 49, 50, 54-56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: Claim 63 contains allowable subject matter, in particular, an elongate stylet disposed at least in part within the inner lumen of the cannula, which is configured for axial translation between a withdrawn position and an extended position.

***Response to Arguments***

10. Applicant's arguments, filed September 20, 2007, with respect to the rejection(s) of claim(s) 58-62 under Burbank et al (6,471,700 B1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Burbank et al (5,928,164), Tihon et al (5,415,656), and Klicek (5,221,281).

11. Applicant's arguments, filed September 20, 2007, with respect to the rejections relying upon Burbank et al (6,471,700 B1) have been fully considered and are persuasive. The rejection of Burbank et al (6,471,700 B1) has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmaj whose telephone number is (571) 272-4733. The examiner can normally be reached on Monday-Friday, with second Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Brian Szmaj  
AU 3736